

### **REMARKS**

Claims 1-12, 17-19 and 22 were examined in the most recent final official action, dated January 22, 2007. All pending claims stand rejected as allegedly being obvious over various combinations of Davis, U.S. Patent No. 5,899,692, Robinson, U.S. Patent No. 4,807,599, Schlachter, U.S. Patent No. 4,648,838, and Nosov, U.S. Patent No. 6,208,788.

The applicants request reconsideration of the rejection and allowance of all claims in view of the amendments made to the claims and the arguments made below.

#### Claims 1, 2, 4-12, 17, and 19 Allowable.

The rejection to claim 1 as obvious over Davis in view of Robinson and in further view of Schlachter should be withdrawn. Claim 1 recites a functional handpiece comprising, in part, a light emission element connected to the remaining region of the functional handpiece by means of a latching device that is integral with the light emission element. The latching device includes a latching nose integral with the light emission element, which can spring in radially inwardly and can self-actingly spring out behind a latching edge on the cannula.

The Office action acknowledges that Davis fails to disclose a latching device. The Office action further fails to allege that Schlachter discloses a latching device. The Office action relies on Robinson for the disclosure of a latching device. However, Robinson only discloses a light emission element with a notch 26, and a housing with a release bar 22 mounted in the housing and biased by a spring 40. The release bar 22 releasably engages the notch 26 of the light emission element. Accordingly, Robinson fails to disclose a light emission element with an integral latching nose that can spring radially inwardly. Accordingly, no cited reference discloses the claimed subject matter.

The cited references further fail to suggest the claimed subject matter. Robinson's light emission element is a tongue depressor. Robinson discloses that the tongue depressor should be rigid so that it can function properly. "In order to provide the blade 14 with sufficient rigidity along the length of the blade 14... In this manner, bending of the blade 14, during use, is resisted." Robinson, col. 5, lines 12-21. Accordingly, Robinson's disclosure as a whole is that of a rigid system. Robinson teaches away from using a flexible material to manufacture his light emission element, and therefore there is no suggestion within Robinson to incorporate a flexible latching nose integral with the light emission element. Robinson fails to suggest a latching nose integral with the light emission element that can spring radially inwardly. See MPEP § 2145(X)(D).

Further, the claimed light emission element omits structure necessary to the system of Robinson and yet maintains the function. "Note that the omission of an element and retention of its function is an indicia of unobviousness" MPEP § 2144.04 (II)(B) (emphasis in original). Robinson requires a separate lever and a separate spring mounted both to the lever and the housing to bias the lever to form a latch. The applicant's system eliminates both the lever and the spring by simply extending a portion of the light emission element to form a flexible latching nose. The elimination of the lever and the spring is an indicia of nonobviousness.

This is not a situation of mere reversal of parts by locating the latch on the light emission element, as argued in the Office action. See MPEP § 2144.04(VI). In a reversal of parts of the Robinson system, a spring would be mounted to the light emission element, and a lever would be mounted to the spring such that the lever would be biased relative to the light emission element by the spring. This construction does not form a flexible latching nose

integral with the light emission element, and even if the parts were reversed, the system would not read on claim 1.

This is likewise not a situation of making previously known parts integral. See MPEP § 2144.04 (V)(B). Instead, the claimed device having a light emission element with an integral latching nose includes completely different structure with advantages over the Robinson device. The claimed device includes fewer parts and allows the device to be easier and faster to manufacture, assemble, and maintain. In the claimed system, no elements outside of the light emission element and cannula are needed to releasably attach the light emission element to the cannula. There is no need to manufacture a separate latching system and install it on the cannula. If the claimed integral latching nose breaks, the user simply replaces the light emission element. If the latch of Robinson breaks, it appears that the entire housing would need to be replaced. The claimed system has advantages in manufacturing and maintenance not available in the disclosed Robinson system. Robinson simply fails to suggest that its tongue depressing element include an integral latching nose.

Davis and Schlachter fail completely to disclose any kind of latching device, and therefore cannot suggest the specific latching device recited in claim 1.

Accordingly, claim 1 is allowable over the cited references. Dependent claims 2, 4-12, 17, and 19 are allowable for at least the same reasons. In particular, none of the cited references discloses or suggests the claimed stepless transition recited in claim 4. Allowance of the aforementioned claims is respectfully requested.

Claims 3, 18 and 22 are Allowable.

Applicants respectfully traverse the rejection to claim 3, as amended, as obvious over Davis in view of Robinson and Nosov. Claim 3 recites a functional handpiece including, in part, a light emission element having a latching device integral with the light emission element, the latching device having a latching nose integral with the light emission element, wherein the light emission element can emit light both forwardly out an end portion of the light emission element and laterally out a side portion of the light emission element.

Claim 3 is allowable for all the same reasons that claim 1 is allowable. None of the cited references disclose or suggest a latching nose that is integral with the light emission element. The addition of Nosov fails to remedy the deficiencies noted above. Nosov fails to disclose any type of latching device for the light emission element. Accordingly, claim 3 is allowable for this reason alone.

Claim 3 is further allowable, because as claim 3 now stands, Nosov is not properly combinable with the remaining references. There is no evidence of record that the light emission element disclosed in Nosov would be able to function properly if a latching nose was made integral with its light emission element. The light emission element of Nosov is a fiber-optic funnel comprising a plurality of fiber-optic strands that transport light from the butt end to the tip of the funnel. No evidence of record discloses how such a fiber-optic funnel could be formed or if it could operate at all with a flexible integral latching nose extending from the butt end. Accordingly, claim 3 is allowable over the art of record. Dependent claims 18 and 22 are allowable for at least the same reasons.

**CONCLUSION**

In view of this amendment, Applicants submit the pending application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

By: /Anthony G Sitko/

Anthony G Sitko  
Registration No. 36,278

MARSHALL, GERSTEIN & BORUN LLP  
6300 Sears Tower  
233 South Wacker Drive  
Chicago, Illinois 60606  
312-474-6300  
Attorney for Applicants

**April 16, 2007**